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| 10/519,768 | 11/17/2005 | Eric Zimmerman | 047P 1861 | 7260 |
| 23460 7590 03/02/2009 LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731 | | | | |
| EXAMINER | | | | |
| KELLY, CATHERINE A | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3634 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,768

Applicant(s)

ZIMMERMAN ET AL.

Examiner

CATHERINE A. KELLY

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Objections

Claim 9 is objected to for awkward grammar, making it hard to follow. Examiner has read the claim as"

--9. (Previously Presented) A motor vehicle door according to claim 1, wherein the door comprises a frame₁ which₁ at its side which is distant to the motor vehicle interior as well as its side which faces the motor vehicle interior₁ in each case comprises a paneling.--

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PG Pub 2004/0211122. The elements of the door of claim 1 are shown in

figures 1, 2a and b, and 4 of the '122 reference where the windowpane is not shown but taught in paragraph [0027], the rail is reference numeral 4, module 3 with spaces for elements unnumbered but clearly shown in figure 4, receiver 30, fixing means 400b, and a bore, unnumbered but inherent from the fastening means which has to go through a bore or hole or something to work and thus a bore is clearly taught. While the fixing means of the '122 reference is not a "screwing" as stated in claim 1, Examiner takes Official Notice that screwing means were well known means of fastening in the art at the time. It would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated to combine because the replacement of the fastening means shown in the '122 reference with a screw would have been an obvious substitution of one known element for another with predictable results.

Regarding claim 2, an additional screwing would be mere duplication of parts and thus obvious, see MPEP 2144.04 VI Section B. One of ordinary skill would be motivated to duplicate because an additional fastener would provide a more secure fastening.

Regarding claim 5, the '122 reference shows two rails in figure 4 reference numeral 4.

Regarding claim 6, the '122 reference teaches a rail made of plastic in claim 4. However, Examiner takes Official Notice that window lifting rails of metal were well known in the art at the time. It would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated to combine

because the substitution of a metal rail for a plastic one would be a substitution of one known element for another with predictable results.

Regarding claim 7, the plastic module is taught in the '122 reference in paragraph [0027].

Regarding claim 8, the door structure is shown in the '122 reference in figures 1 and 4 where the inner panel is reference numeral 1 with module 3 attached at base structure profile 13 and outer skin 2.

Regarding claim 9, the door frame is shown in the '122 reference in figures 1 and 4 where the door frame 6 has attached inner panel 1 and outer panel 2.

Regarding claim 10, the module accommodating loud speakers is shown in figure 4 where the unnumbered round region in module 3 is clearly for a loud speaker.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0211122 as applied to claim 1 above, and further in view of US PG Pub 2004/0049988. The '122 reference shows the alignment of the window lifting rail on the module in figures 2a and b where the rail is reference numeral 4 and the module 3. However, the '122 reference shows the alignment via bearing and an axel, not the pin of claim 3. The pin structure is shown in the '988 reference in figure 2b reference numeral 56. It would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated to combine because the replacement of the positioning axel with a pin would be substitution of one known element for another with predictable results.

Regarding claim 4, two pins instead of one would be mere duplication of parts and thus obvious, see MPEP 2144.04 VI Section B. One of ordinary skill would be motivated to use two pins instead of one as two pins may provide a more definite alignment.

Response to Arguments

Applicant's arguments with respect to claim 1 in regards to the bore have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 12/2/2008 have been fully considered but they are not persuasive. Applicant argues that the screwing and bore of the '122 reference are not in the vertical direction. As the present application drawings show both a vertical and a horizontal screw, both correlating with a receiver, Examiner read the term vertical broadly. Further, the limitation vertical without definition by reference to some other orientation or placement is in and of itself, without reference to the applicant's drawings, broad enough to cover any orientation. Thus, the vertical axis of the '122 reference vehicle could be the same direction as fastening means 400b and therefore fastening means 400b and its corresponding bore are in the vehicle vertical axis direction.

In regards to applicant's argument that the receiver of the '122 reference does not support the vertical weight forces of the rail, Examiner respectfully disagrees and maintains that the '122 reference receiver 30 does support rail 4's vertical weight as clearly shown in the engaged position of figure 1 and enlarged in figure 3b. As rail 4 is hanging from receiver 30, the receiver must be supporting the rails weight or the invention would break.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHERINE A. KELLY whose telephone number is (571)270-3660. The examiner can normally be reached on Monday through Friday 9am - 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. K./
Examiner, Art Unit 3634

/KATHERINE W MITCHELL/
Supervisory Patent Examiner, Art
Unit 3634

cak